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WASHINGTON, D.C. 20231
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R2003-85

FEB 10 2003

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In re : DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 2, 19 and 24 of the morning section and questions 1, 11, 39, and 43 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64. On July 17, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been granted any additional points on the Examination. Petitioner's arguments for morning questions 2, 19 and 24 and afternoon questions 1, 11, 39, and 43 are addressed individually below.

Morning question 2 reads as follows:
2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

(A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.

(B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.

(C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.

(D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.

(E) (B) and (D).

2. The model answer: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30

days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

Petitioner argues that answer (E) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner argues, in effect, that question 2 is so unclear that no correct answer to the question can be ascertained. According to petitioner, "this question is flawed" and the reason that it is flawed is because "[A] person attempting to answer this question would have to make assumptions about this question." Petitioner contends, for example, that the "counterpart application" referred to in the question is not necessarily counterpart to the application at issue in the question. Petitioner also points to the sentence in the question reading: "The client is very desirous of having this cited art made of record in the file." According to petitioner, it is not clear whether the file in which the client desires to have art made of record is the file of the application at issue or "a different file Pete has". Question 2, however, does not refer to a different file Pete has. Contrary to petitioner's assertion that the question is so unclear that no correct answer to the question can be ascertained, petitioner has erroneously interjected considerations that are not called for by the question. Note that the directions to the morning and afternoon sections state, in part: "Do not assume any additional facts not presented in the questions." Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 19 reads as follows:

19. On June 9, 2000, you file two complete patent applications on behalf of your client, ABC Inc. The subject matter of the patent applications relates to a new automotive body design. One of the applications is filed as a utility application (A#1), and other is filed as a design application (A#2). Prosecution of each application moves forward independently of each other, and you receive final office actions in each application rejecting the respective claim(s) in each application. Your client, in consultation with you, decides that she would rather pursue prosecution in each case rather than appeal the final rejections. Which of following options is available to you under the USPTO rules and procedures ?

(A) File a request for continuing examination (RCE) for both A#1 and A#2.

(B) File a request for continuing examination (RCE) for A#1 and a continuing prosecution application (CPA) for A#2.

(C) File a request for continuing examination (RCE) for A#2 but not A#1.

(D) File a continuing prosecution application (CPA) for both A#1 and A#2.

(E) File a continuing prosecution application (CPA) for A#1 but not A#2.

19. The model answer: (B). 37 C.F.R. § 1.153(d)(I)(i)(B). A design application is eligible for continuing prosecution application procedures. 37 C.F.R. § 1.114 (e)(4) explains that RCE procedure is not available for design applications, therefore (A) and (C) are wrong. Answer (D) is wrong because under 37 C.F.R. § 1.53(d) the filing date of the application (A#1) must be before May 29, 2000. Answer (E) is wrong for the same reason.

Petitioner argues that answer (A) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner argues, in effect, that question 19 is so unclear that no correct answer to the question can be ascertained. Specifically petitioner states:

> The question reads 'On June 9, 2000 you file two complete patent applications on behalf of your client, ABC inc.' Where are the applications filed? An application can be filed with a clerk in a law office, an application can be filed in a folder for safekeeping, or an application can be filed in the USPTO.

Again, petitioner is interjecting considerations not called for by the question. The question does not mention "a clerk in a law office." Nor does the question mention "a folder for safekeeping." The question does say, however, that prosecution occurs after the filing of each application. Further, the directions to the morning and afternoon sections state, in part: "Do not assume any additional facts not presented in the questions" and "unless otherwise stated, assume that you are a registered patent practitioner." Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 24 reads as follows:
24. Mr. Brick, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "Y". Brick receives a first Office action dated June 4, 2001 from the primary examiner handling Brick's application. The examiner rejected Brick's claim only under 35 U.S.C. § 103 on the grounds that Reference X teaches a bouncing ball called "Q," and that although "Y" and "Q" are not the same, it would have been obvious to one of ordinary skill to make changes to the "Q" ball in order to obtain a ball just like Brick's "Y" ball. On August 2, 2001, Brick responds by stating that his new "Y" ball bounces unexpectedly higher than the "Q" ball described in Reference X. Brick includes a declaration, signed by Mrs. Kane, that includes extensive data comparing the bouncing results for the "Y" and "Q" balls and showing that the "Y" ball bounces unexpectedly higher than the "Q" ball. Brick argues that the rejection under 35 U.S.C. § 103 should be withdrawn because he has proven that, in view of the unexpectedly higher bounce of the "Y" ball as compared to the "Q" ball, it would not have been obvious to one of ordinary skill in the art to make changes to the "Q" ball to obtain Brick's "Y" ball. On October 2, 2001, Brick receives a final rejection from the examiner. The rejection states, in its entirety: "The response has been reviewed but has not been found persuasive as to error in the rejection. The claim is finally rejected under 35 U.S.C. § 103 for the reasons given in the first Office action." Brick believes he is entitled to a patent to his new bouncing ball "Y." How should Brick proceed?

(A) Brick should give up because the declaration did not persuade the examiner of the merits of Brick's invention.

(B) Brick should timely file a Request for Reconsideration asking the examiner to reconsider the rejection on the basis of the Kane declaration and, as a precaution against the Request for Reconsideration being unsuccessful, also timely file a Notice of Appeal.

(C) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide an enabling disclosure for a new ball with the unexpectedly higher bounce of his "Y" ball.

(D) Brick should respond by submitting a request for reconsideration presenting an argument that Reference X does not provide a written description for a new ball with the unexpectedly higher bounce of his "Y" ball.

(E) Brick should respond by submitting a request for reconsideration presenting an argument the declaration data proves that the "Q" ball and the "Y" are not identical.

24. The model answer: (B) is the correct answer. It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The examiner has not analyzed the data in the declaration nor provided an explanation as to why the declaration did not overcome the rejection. Furthermore, the rejection has not been reviewed anew in light of

the declaration. The examiner should have reweighed the entire merits of the *prima facie* case of obviousness in light of the data. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). Accordingly, Brick should ask that the rejection be reconsidered and file a Notice of Appeal to safeguard his interest for a review of the rejection by the Board of Patent Appeals and Interferences if the rejection is not reconsidered. 37 C.F.R. § 1.116. (A) is wrong because there is no evidence that the examiner made any review of the declaration. (C) is wrong because whether or not Reference X provides an enabling disclosure for Brick's invention is immaterial to the question of obviousness. If there were to be a question of enabling disclosure for Reference X, it would be with respect to the "Q" ball relied upon by the examiner, not applicant's "Y" ball. (D) is wrong because whether or not Reference X provides a written description for Brick's invention is immaterial to the question of obviousness raised by the examiner. (E) is wrong because the issue is one of obviousness under 35 U.S.C. § 103, not identity under 35 U.S.C. § 102. Given that the examiner has rejected the claim under 35 U.S.C. § 103 and not under § 102, the examiner has already conceded that the "Q" and "Y" balls are not the same.

Petitioner argues that answer (C) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner states that "question 24 is flawed" and argues that the question is so unclear that no correct answer can be ascertained. Petitioner's arguments reveal that petitioner is not familiar with declarations presenting evidence of "unexpected results." Further, petitioner's arguments indicate that petitioner erroneously assumed that the USPTO may disregard "extensive data" presented as evidence of unexpected results. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:
1. Mr. Block, the inventor, files an application with the USPTO on January 2, 2001 containing a single claim for his invention: a new bouncing ball called "O." As part of his duty of disclosure, he also files a copy of a written agreement that he and Mrs. Cone signed on January 2, 1998. The agreement states, in its entirety, that "Mr. Block will transfer my new bouncing ball 'O' to Mrs. Cone for experimental uses only to perfect the ball's bounce. Mr. Block retains full control over the new bouncing ball 'O.'" The primary examiner has no evidence that the ball was ever actually delivered to Cone. On June 2, 2001, Block receives an Office action dated June 4, 2001 from the primary examiner. The examiner has rejected Block's claim only under 35 U.S.C. § 102(b). The examiner explains in the Office action that "the 1998 written agreement signed by Block and Cone proves that the new bouncing ball 'O' was in public use more than one year prior to the January 2, 2001 filing date of the application." Block believes he is entitled to a patent for his new bouncing ball "O." How should Block respond to the rejection of his claim?

(A) Block should give up because the agreement is dated more than one year before the filing date of the application and that is enough to statutorily bar Block from getting a patent under 35 U.S.C. § 102(b).

(B) Block should respond by arguing that although the agreement was signed more than one year prior to the filing date of the application, it was never published and therefore cannot be relied upon as a "printed publication" under 35 U.S.C. § 102(b).

(C) Block should respond by presenting evidence by way of an oath or declaration of experimental use and arguing that any use of the ball by Cone would have been experimental use, not "public" use.

(D) Block should respond by arguing the agreement was signed by him, the same person who filed the application, which means that the invention was not "known or used by others in this country."

(E) Block should respond by arguing that even though the agreement may suggest that the ball was in use more than one year prior to the filing of the application, it does not indicate that the ball was put on sale in this country.

1. The model answer: (C) is the correct answer. MPEP § 2133.03(e). The issue is whether the invention was in "public use" more than one year prior to the filing of the application. The crux of the issue is whether the agreement, which is the only evidence the exa miner relied upon, indicates that a "public" use has occurred. Issues arising under the public use bar of 35 U.S.C. § 102(b) are determined by considering the totality of the circumstances. In re Brigance, 792 F.2d 1103, 1107, 229 USPQ 988, 991 (Fed. Cir. 1986). The circumstances are that: 1) Even if Cone received the ball, she was limited to using it for experimental, not public, uses. And, finally, 2) even though Cone can conduct experiments with the ball, control of the ball remains with Block. In view of all these facts, the totality of the circumstances leads to the conclusion that a "public use" more than one year prior to the filing of the application did not occur. In view of this response, and assuming no other evidence of a public use is available, the rejection under 35 U.S.C. § 102(b) under these grounds should be withdrawn. (A) is wrong because it is not enough that a document is dated more than one year prior to the filing date of an application for it to constitute a statutory bar under 35 U.S.C.§ 102(b). The issue to be addressed by Block is whether the examiner appropriately rejected the claim over the "public use" clause of 35 U.S.C. § 102(b), not the "printed publication" clause. (B) is wrong because whether or not the agreement is a printed publication is irrelevant. The rejection is on the grounds of "public use", not "printed publication". (D) is wrong because the issue of whether an invention was "known or used by others in this country" is relevant to a rejection under 35 U.S.C. § 102(a), not § 102(b) which is at issue here. Furthermore, the fact that Cone also signed the agreement suggests "others" were associated with the use of the invention which would mean this response is incorrect even if the issue was the propriety of a rejection under 35 U.S.C. § 102(a). In that situation, the issue would not be whether it

was used by others, since it plainly was, but rather whether the use was a "public" one. (E) is wrong because it assumes that the issue is whether the invention was "on sale". While the rejection was under 35 U.S.C. § 102(b), the "public use" clause, not the "on sale" clause is at issue. Whether or not the ball was on sale or not is irrelevant to overcoming the rejection.

Petitioner argues that answer (B) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that "[T]he question as poised [sic] is impossible to answer correctly" due to a typographical error contained in the fact pattern of the question. The fact pattern states: "On June 2, 2001, Block receives an Office action dated June 4, 2001 from the primary examiner." Clearly the Office action cannot be received before it is mailed. However, the actual mailing date of the Office action has no bearing on the question *posed*. The only dates that are relevant to any of the answer choices, are the date the "written agreement" was signed (January 2, 1998), and the date the application was filed (January 2, 2001). Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 11 reads as follows:
11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

(A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.

(B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.

(C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.

(D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.

(E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

11. The model answer: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7).

Petitioner argues that answer (E) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Again, petitioner argues, in effect, that the question is so unclear that no correct answer to the question can be ascertained. Specifically, petitioner contends "it is impossible to tell what Henrietta wants to file an application for." The call of the question reads: "Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?" As there are only two aspects of Henrietta's invention discussed in the fact pattern, the question is clear as to what subject matter is covered by "both aspects of her invention". Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 39 reads as follows:
39. A nonprovisional application under 37 CFR 1.53(b) is filed with a check for the exact amount of a small entity basic filing fee. A registered practitioner's well trained legal assistant when filing the application forgot to also submit a written assertion of entitlement to small entity status that had been executed by the sole assignee who is a small entity. Which of the following is/are in accordance with proper USPTO practice and procedure?

(A) Applicant need not supplement the initial filing with the omitted written assertion of small entity status as the payment of the small entity filing fee will suffice to accord small entity status.

(B) If the application is allowed, applicant cannot pay the issue fee in the small entity amount unless the fee is accompanied by a written assertion of small entity status.

(C) If after filing of the application small entity status becomes no longer appropriate, applicant may continue to pay small entity fees for newly added claims in a response to a first Office action rejection.

(D) If the application is allowed, a registered practitioner could pay a small entity issue fee solely based on the assignee's written assertion of small entity status that was not originally submitted if the practitioner now submits it with the issue fee.

(E) (A) and (C).

39. The model answer: (E) is the correct answer as both answers (A) and (C) are in accordance with Office practice. Answer (A) is a correct answer as the payment of the small entity filing fee will be treated as a written assertion of entitlement to small entity status pursuant to 37 C.F.R. § 1.27(c)(3). Answer (C) is a correct answer as once small entity status is properly established on filing of the application small entity fees may continue to be paid without regard to a change in status, such as for a claim fee, until the issue fee is due pursuant to 37 C.F.R. § 1.27(g)(1). Answer (B) is not a correct answer. Although a new determination of entitlement to small entity status is made upon payment of the issue fee, a written assertion of entitlement to small entity status is not required at this time. Once established, small entity status remains in effect unless the facts change. Answer (D) is not a correct answer. At the time of payment of the issue fee the registered practitioner cannot rely upon the previous written assertion of small entity status completed at the time of filing the application. Applicant must conduct a new investigation as to entitlement to small entity status at the time of payment of the issue fee pursuant to 37 C.F.R. § 1.27(g)(1). If small entity status is determined to continue to be appropriate at the time of payment of the issue fee, a small entity issue fee can be paid based on such determination and a written assertion need not be presented at that time pursuant to 37 C.F.R. § 1.27(e)(1).

Petitioner argues that answer (A) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner argues, in effect, that this question is so unclear that no correct answer to the question can be ascertained. Specifically petitioner states:

> The question reads 'A nonprovisional application under 37 CFR 1.53(b) is filed with a check for the exact amount of a small entity basic filing fee.' Where is the application filed? An application can be filed with a clerk in a law office, an application can be filed in a folder for safekeeping, or an application can be filed in the USPTO.

37 CFR 1.53(b) states, in part: "The filing date of an application for patent under this section... is the date on which a specification... and any drawing... *are filed in the Patent and Trademark Office.*" (Emphasis added.) Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 43 reads as follows:
43. On December 24, 2001, you were retained to file a U.S. nonprovisional patent application for inventions X, and Y. In preparing the U.S. patent application, you discovered that the same inventors filed an application for invention X in Germany on December 28, 2000 and an application for inventions X and Y in France on March 13, 2001. The German application was never published and was abandoned on July 2, 2001. What is the latest date you could file a U.S. patent application at the USPTO to properly have the right of priority for the inventions disclosed in the U.S. patent application?

(A) December 27, 2001 (Thursday)

(B) December 28, 2001 (Friday)

(C) January 2, 2002 (Wednesday)

(D) March 12, 2002 (Tuesday)

(E) March 13, 2002 (Wednesday)

43. The model answer: The correct answer is (B). See MPEP § 201.13. An application must be filed in the U.S. within 12 months from the earliest foreign filing, except as provided in 35 U.S.C. § 119(c). Therefore, you would have one year from December 28, 2000 to file in the U.S. because invention X was first filed in Germany on December 28, 2000. Thus, you have until December 28, 2001 and the USPTO is open for business. The exception in 35 U.S.C. § 119(c) does not apply because the German application was abandoned after the filing of the second foreign application, the French application. Further, the subsequently filed application must be filed in the same country. Answer (A) is not the latest date to file. See 35 U.S.C. § 21 and MPEP § 201.13, Part D. Answer (C) is too late to obtain the right of priority for invention X inasmuch as the USPTO was open for business on December 28, 2001. Answers (D) and (E) are also too late to obtain the right of priority for invention X as it was disclosed in a foreign application more than a year prior to those dates.

Petitioner argues that answer (E) should be accepted. Petitioner's arguments have been fully considered but are not persuasive. Petitioner argues, in effect, that this question is so unclear that no correct answer to the question can be ascertained. Petitioner makes the same type of argument that petitioner made with respect to morning question 19 and afternoon question 39. Suffice it to say that afternoon question 43 is very clear that the German and French filings were, in fact, German and French patent application filings. The call of the question reads: "What is the latest date you could file a U.S. patent application at the USPTO to properly have the *right of priority* for the inventions disclosed in the U.S. patent application?" (Emphasis added.) It is unclear how petitioner

could have thought that a "right of priority" could be based on papers delivered to a law clerk or foreign associate or on papers placed in a folder for safekeeping. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 64. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy